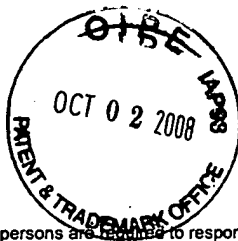


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TRI04546P00161US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 30, 2008

Signature Karen Sanderson

Typed or printed name Karen Sanderson

Application Number

10/692,703

Filed

October 24, 2003

First Named Inventor

Joseph M. Koenig, Jr.

Art Unit

3723

Examiner

Maurina T. Rachuba

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 37,825

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Jeffery N. Fairchild

Typed or printed name

312/876-1800

Telephone number

September 30, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



TRI04546P00161US
PATENT

STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-12 are pending and at issue. Claims 1, 2, 5 and 9 stand rejected as unpatentable over Kingman 2,386,900 in view of Meyer 5,439,545; and claims 3, 4, 6-8 and 10-12 stand rejected as unpatentable over Kingman in view of Meyer as applied to claim 1, and further in view of Hays 2,553,254.

The clear error in the rejections is the improper modification of Kingman with Meyer, and the failure to state any rationale or cite any evidence whatsoever for the proposed modification of Kingman with Hays.

The Rejection Ignores the Express Teachings of Kingman and Proposes a Modification That Is Contrary to These Express Teachings

The prior art must be considered in its entirety, including disclosures that teach away from the claims, and references cannot be combined where references teach away from their combination (see MPEP §2145 D), Kingman expressly states that it's object is to provide a scouring device having "a substantially rigid body or core" (Kingman, col. 1, lines 8-1) and consistent with this object, repeatedly teaches that it's scouring device should have a rigid body or block (see, for example, col. 1, lines 41-46 and the first line of each of claims 1-5). In this regard, the requirement for a "rigid block" in each of the claims cannot be ignored because it is the claims that describe the invention and Kingman expressly requires "a rigid block" in every single claim defining its invention. Despite this overwhelming showing in Kingman, the present Office Action continues to assert that it would be obvious to replace the rigid block required for the invention of Kingman with a

non-rigid body as allegedly taught by Meyer. It is that specific substitution required by the proposed modification in rejecting the claims that is expressly taught away from by Kingman's requirement that it have a substantially rigid body or core. For this reason alone, the proposed modification in the rejection is improper and should be withdrawn.

In response to the above argument, the present Office Action asserts that "It is the Examiner's position that Kingman therefor teaches the desirability of providing at least part of the tool with a material that is flexible and compressible." (emphasis added) However, this assertion conveniently ignores Kingman's very express teaching that "at least part of the tool" be made from a rigid material, and specifically that the body of the tool be "a rigid block". In making a rejection, the Examiner is not allowed to simply ignore portions of the prior art that are inconvenient for the arguments asserted by the Examiner.

The current Office Action goes on to assert that "There is no teaching against providing at least part of the tool of a flexible and compressible material." Again, this assertion ignores the fact that there is an express teaching in Kingman against providing an entire tool of a flexible and compressible material such as is proposed in the rejection.

The present rejection also asserts that "it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand tool that conforms to the shape of the workpiece." (emphasis added) However, this benefit is already expressed achieved by the structure in Kingman. In this regard, Kingman expressly states at column 3, lines 45-54 that "Since the coating 19 of the device is, per se, of resilient character, the same will sufficiently yield under pressure toward the surface

undergoing treatment as to assure intimate conforming contact therewith, and so as to further assure that the abrasive material or grit 20 carried thereby will be brought into intimate and firm scraping and scouring engagement with said surface, when the device is rubbed back and forth over the latter.” Thus, Kingman’s disclosure that “the material of the tool” was “selected to conform to the shape of the workpiece” could not be any clearer, and the benefit argued in the rejection is thus already expressly achieved by the unmodified structure in Kingman. It cannot be obvious to modify a structure to provide a benefit that is already provided by the structure. In this regard, it should be noted that no rationale is provided in the rejection as to why the proposed modification would provide a superior result with respect to conforming to the shape of the workpiece than what is already expressly achieved by Kingman.

The present Office Action also asserts that “Meyer clearly teaches making a tool with the entire tool being made of a material that is flexible and compressible, to allow the entire tool to conform to the surface being abraded.” However, this assertion ignores that Kingman teaches exactly the opposite of this by requiring a rigid body or block. Kingman cannot be modified contrary to its express teachings, regardless of what Meyer may or may not teach.

Accordingly, for each of these additional reasons, the rejections based on the modification of Kingman with Meyer is improper and should be withdrawn, including the rejection of claims 3, 4, 7 and 8.

**The Rejection Fails to State Any Rationale Whatsoever
for the Further Modification of Kingman with Hays**

The present Office Action fails to state any rationale or cite any evidence whatsoever for its proposed modification of Kingman with Hays. Indeed, no Office Action in this case has provided such a rationale, despite numerous and express requests for such a rationale. Rather, the rejection acknowledges the shortcomings of its combination of Kingman and Meyer with respect to claims 3, 4, 6-8 and 10-12, and then discusses the structure allegedly disclosed by Hays, without any statement whatsoever as to why one skilled in the art would further modify Kingman with the disclosure of Hays. Absent such a rationale, the rejection fails to meet the standards set forth in the MPEP for stating a *prima facie* case of obviousness and accordingly, it is improper and should be withdrawn. For this additional reason, it is believed the rejection of claims 3, 4, 6-8 and 10-12 is improper.

In view of the foregoing, Applicant respectfully requests reconsideration of the finality of the rejection and the rejections of claims 1-12, and allowance of the case.